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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,787	06/26/2003	Richard D. Lee	FINEL:63549	6894

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EXAMINER
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WRIGHT, ANDREW D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/608,787

Applicant(s)

LEE ET AL.

Examiner

Andrew Wright

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 12/4/03.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 12/4/03 has entries in the "Other Prior Art" category that lack sufficient information (dates, etc.). These entries have not been lined through. The documents have been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for linking comprising an electrical switch (claim 4) and the exhaust system, secondary exhaust system, and valve (claim 19) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Objections***

3. Claim 1 is objected to for reciting "An apparatus and method" in line 1. It is improper to recite an apparatus and method. Since no method steps are recited, it will be assumed that the claim is an apparatus claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 19-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 19 recites an exhaust system that directs exhaust from the rear of the boat, a secondary exhaust that directs exhaust vertically, and a valve in the exhaust system capable of diverting from the exhaust system into the secondary exhaust system. These features are not adequately described in the specification and drawings. Claims 20-22 depend from claim 19.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Polakowski (US 6,135,834). First conduit (82) has port side outlet at port side sponson (32). Second conduit (80) has starboard side outlet at starboard side sponson (34). Both conduits are connected to exhaust manifold (164) (figure 11). Valve means (86 and 92) for directing the exhaust are connected to the conduits.

8. Regarding claim 2, the conduits include connecting portions (166, 168). Figure 11 shows a 90° connection between the conduits (166, 168) and the manifold (164)

9. Regarding claim 3, the valve means comprises first valve (92) connected to the first conduit (82) and second valve (86) connected to the second conduit (80). Valve means also comprises a means for linking the valves so that opening of one causes closing of the other such that more exhaust is directed to one side of the boat than the other. Means for linking comprises link (170).

10. Regarding claim 5, link (170) is a mechanical linkage between the valves.

11. Regarding claim 6, the valve means comprises first valve (92) connected to the first conduit (82) and second valve (86) connected to the second conduit (80). Valve means also comprises a means for linking the valves so that opening of one causes closing of the other such that more exhaust is directed to one side of the boat than the other. Means for linking comprises link (170). The apparatus further comprises control means for controlling the valves. Control means comprises handle bar (38) and cable (60). The control means directs more exhaust to one side or the other of the boat.

12. Regarding claim 8, the means for linking comprises mechanical linkage (170). Handlebar (38) and cable (60) are a mechanical control that is connected to the linkage for controlling the valves.

13. Polakowski as described above contains all of the recited elements of claims 10-12 and 14-16.

14. Although claims 19-22 are already rejected under 35 USC 112/1<sup>st</sup>, art will be applied to the claims as best understood. Claims 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schlichthorst (US 4,586,908). Schlichthorst shows a boat with an exhaust apparatus. The apparatus comprises an exhaust system (6) and a secondary exhaust system (4). The secondary exhaust system directs exhaust in a vertical direction away from any wake of the boat. The apparatus comprises a valve (3) that is in the exhaust system and diverts exhaust from the exhaust system to the secondary exhaust system. Control mechanism (3', 16, 18, and 20) actuates the valve. The recitations of a manifold and the rear of the boat have not been given patentable weight because the recitations occur in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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15. Regarding claim 20, the control mechanism comprises control (20) that is remote to the operator.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 4, 13, 8, 9, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polakowski (US 6,135,834). Regarding claims 4 and 13, Polakowski does not disclose that the embodiment of figure 11 can be used with electrically controlled valves and an electrical switch. Polakowski does disclose that an earlier embodiment (figure 8) can utilize either mechanical valves and controller or electrical valves and control electronics including a switch (column 7, lines 20-40). Based upon the teaching of equivalence in the earlier embodiment, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the embodiment of figure 11 by using electrical valves and control electronics. Polakowski teaches that a major advantage (i.e. motivation) is the ability to electrically control the valves.

18. Regarding claims 8, 9, 17, and 18, Polakowski does not explicitly disclose the recited method steps. The steps, however, are inherent in the making and use of the Polakowski apparatus as described above. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to devise the

claimed method steps based upon the making and use of the Polakowski apparatus.

The motivation would be to use the Polakowski apparatus.

19. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schlichthorst (US 4,586,908) in view of Polakowski (US 6,135,834). Schlichthorst contains the limitations of claim 20. Schlichthorst does not show that the remote control is a cable between the valve and a lever. Polakowski teaches equivalence between an electrical control system and a mechanical control system with a cable and lever. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Schlichthorst by a mechanical control system with a cable and lever. The motivation would be to allow the user to have an actual control over the valve.

20. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schlichthorst (US 4,586,908). Schlichthorst contains the limitations of claim 20. Schlichthorst shows that the valve is actuated by control motor (3') but does not specify that the motor is an electric motor. Schlichthorst shows that the remote control (20) receives a signal from sensor (18) then energizes the motor (3'), but does not explicitly disclose a switch. It is well known and common for control mechanisms such as this to employ an electronic controller and electric actuators. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Schlichthorst by using an electronic controller for member (20) and an electric motor for motor (3'). The motivation would be to use small, lightweight components that are common in the art.



***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Porter shows an exhaust system that directs exhaust to the sides of the boat. Salo shows an exhaust system with a control valve that selectively directs exhaust to the sides of the boat. Griffiths et al. shows a control valve for selectively directing exhaust gasses between one conduit or another.

22. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1113.

Andrew D. Wright  
Patent Examiner  
Art Unit 3617

*AW* 4/15/04